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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,869	04/16/2004	Ricardo Alexander Gomez	5285-0002	9828

35301 7590 04/04/2006

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT PAPER NUMBER

3739

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,869

Applicant(s)

GOMEZ, RICARDO ALEXANDER

Examiner

Matthew J. Kasztejna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 41 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Disposition of Claims

In response to the amendment filed on January 19, 2006, amended claims 1-15; canceled claims 16-40 and new claims 41-42 are acknowledged. The current rejections are *withdrawn*. The following new grounds of rejection are set forth:

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the valve mechanism must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 10-15 and 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication 2002/0022762 to Beane et al.

In regards to claim 1, Beane et al disclose a sterile apparatus to protect endoscopes comprising: an impact resistant housing 110 having an outer surface defining an opening, an interior of the housing defining a canal having a first end communicating with the opening and a second end terminating within the housing for receiving a distal lens of an endoscope (see Figs. 2a-f); and a defogging material disposed adjacent to the second end of the canal for defogging a distal lens of an endoscope when inserted within the canal (see paragraph 0056).

In regards to claims 2 and 4, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the canal is shaped for receiving a plurality of types of endoscopes (see paragraph 002).

In regards to claim 3, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the apparatus is made of disposable material as it is well-known that all materials regardless of composition are capable of being disposed.

In regards to claim 5, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the apparatus is configured to protect endoscopes during intermittent use (see paragraphs 007-0016).

In regards to claim 6, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the apparatus is inherently configured to protect endoscopes during transportation (see Fig. 2a).

In regards to claim 7, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the interior of the housing includes: a storage sheath defining the canal, the outer surface of the housing and the storage sheath defining a cavity therebetween; and an impact absorbing material substantially filling the cavity (see Figs. 2a-f).

In regards to claim 10, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the impact absorbing material is a liquid (see paragraph 0057-0058).

In regards to claim 11, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the impact absorbing material is a gas (see paragraph 0060).

In regards to claims 12-15, Beane et al disclose a sterile apparatus to protect endoscopes, further comprising an anchor and a cord attached to the housing and the anchor, to be used for a means for removable affixing the housing to a surface (see paragraphs 0066-0068).

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In regards to claims 41-42, Beane et al disclose a sterile apparatus to protect endoscopes, further comprising a reservoir for communicating with the second end of the canal for accommodating the defogging material (see paragraphs 0012-0013)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0022762 to Beane et al. in view of Dohm et al. (U.S. Patent No. 5,720,391).

In regard to claim 8, Beane et al. disclose a sterile apparatus to protect endoscopes but are silent with respect to wherein the impact absorbing material is Styrofoam. However, Dohm et al. teach a similar transportation case for a medical instrument having a spacer 212 made of shock absorbing material, such as a styrofoam material (see col. 5, lines 64-66). Dohm et al. thus demonstrate that the use of styrofoam materials for cushioning a medical device during transport are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize Styrofoam in the apparatus of Beane et al. as an alternate means for cushioning the endoscope.

Claims 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0022762 to Beane et al. in view of Lantz (U.S. Patent No. 6,910,582).

In regard to claim 9, Beane et al. disclose a sterile apparatus to protect endoscopes but are silent with respect to wherein the impact absorbing material is a gel. However, Lantz teaches a similar transposition case having a gel pack 40 for cushioning (see col. 5, lines 55-65). Lantz thus demonstrates that the use of gel materials for cushioning is well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize a gel in the apparatus of Beane et al. as an alternate means for cushioning the endoscope.

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

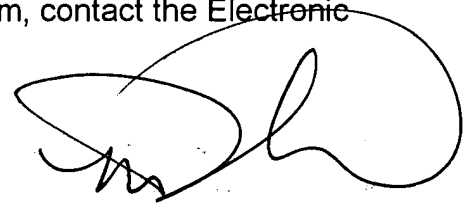
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK MK

3/29/06



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